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09/779,558	02/09/2001	Yuichi Itoh	1254-0170P	6155

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/779,558

Applicant(s)

ITOH ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10, 14-16 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 1 and 12 is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, 11-13 and 17-20, drawn to a crosslinked olefinic thermoplastic elastomer composition, classified in class 524, subclass 80.
  - II. Claims 9 and 10, drawn to a method of manufacturing an olefinic thermoplastic elastomer composition, classified in class 525, subclass 192.
  - III. Claim 23, drawn to a method of manufacturing an olefinic thermoplastic elastomer composition, classified in class 525, subclass 192.
  - IV. Claims 14-16, drawn to an electronic apparatus or transporting machine comprising the composition of group I and glass, classified in class 428, subclass 548.
  - V. Claims 21 and 22, drawn to a molding obtainable from the composition of group I, classified in class 428, subclass 548.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and III are related to the invention of group I as processes of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the processes as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by a materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made

by another and materially different process not involving dynamic heat treatment (static curing). Also, the product as claimed can be made by materially different processes as, evidenced by groups II and III.

3. Inventions IV and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a subcombination can be used as defined in claim 17. The subcombination has separate utility in articles such as building materials.

4. Inventions I and V are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful in preparing coated articles and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly

admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Inventions II-V are unrelated. They are not disclosed as capable of use together and they have different modes of operation or different functions (MPEP § 806.04, MPEP § 808.01).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group II-IV is not required for Group I, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for Group IV or V is not required for Group II or III, restriction for examination purposes as indicated is proper.

9. During a telephone conversation with Marc Weiner on 89/27/02, a provisional election was made with traverse to prosecute the invention of group I, claims 1-8, 11-13

and 17-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9, 10, 14-16 and 21-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

11. The information disclosure statement filed 2/9/01 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of the Japanese patent not in the English language. The IDS has been considered to the extent that it is comprehensible in the English language

#### ***Claim Objections***

12. Claims 1 and 12 are objected to because of the following informalities: The word "perfectly" in the first line of the claims should be replaced with "fully" in order to clarify the claim language. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 4-8, 11, 13 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claims 4 and 6 each recite the limitation "the crosslinking agent" in claim 1. There is no positive recitation of a "crosslinking agent" in claim 1 and there is insufficient antecedent basis for this limitation in these claims.

16. Claim 5 recites the limitation "the gel content" in claim 4. There is no positive recitation of "gel content" in claim 4 and there is insufficient antecedent basis for this limitation in the claim. It is unclear to which component of the composition the "gel content" is referring.

17. Claim 7 recites the limitation "the gel content" in claim 6. There is no positive recitation of "gel content" in claim 6 and there is insufficient antecedent basis for this limitation in the claim. It is unclear to which component of the composition the "gel content" is referring.

18. Claim 8 recites the limitation "the haze value" in claim 1. There is no positive recitation of a "haze value" in claim 1 and there is insufficient antecedent basis for this limitation in the claim. It is unclear to which component of the composition the "haze value" is referring.

19. Claims 11 and 13 each recite the limitation "the dynamic heat treatment" in claims 1 and 12, respectively. There is insufficient antecedent basis for this limitation in these claims.

20. In claims 11, 13, 17, 18 and 20, the term "**obtainable**" renders the claims indefinite because (1) it is unclear whether the process limitations following the terms are parts of the claimed inventions or simply exemplary of numerous potential methods for obtaining the claimed inventions, (2) it is unclear whether the claimed compositions are **necessarily** obtained by the process(es) recited in the claims, and (3) the scopes of the claims are unascertainable since it brings into question whether applicant is actually claiming the composition obtained from the process(es) or simply any thermoplastic elastomeric composition, which may or may not be obtained from the process(es).

Claim 19 depends from claim 17, and thus incorporated the indefiniteness.

### ***Claim Rejections - 35 USC § 102/103***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:



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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-8, 11 and 17-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Rinehart (USPN 4,220,579), Mathews et al. (USPN 4,239,862) or Abdou-Sabet et al. (USPN 4,311,628).

In col. 1, lines 52-68, col. 2, lines 33-50, col. 3, lines 49-51, col. 8, lines 64-67 and the examples, Rinehart teaches an at least partially cured thermoplastic elastomeric composition comprising 15 to 80% of an ethylene-based copolymer rubber, 15 to 80% of a crystalline polypropylene resin and 10 to 20 parts, based on a total 100 parts of the polymer resin/rubber, of an at least partially paraffinic mineral oil softening/extender oil, wherein the oil is exemplified by a paraffinic oil having a flash point of about 450 °F (about 232 °C). See col. 10, lines 29-37.

In col. 1, lines 31-68, col. 2, lines 38-50 and col. 3, lines 65-66, Mathews et al. teach an at least partially cured thermoplastic elastomeric composition comprising 15 to 80% of an ethylene-based copolymer rubber, 15 to 80% of a crystalline polypropylene resin and 0 to 40 % of a preferably paraffinic mineral oil softening/extender oil, wherein the oil is exemplified by a paraffinic oil having a flash point of about 450 °F (about 232 °C). See col. 6, lines 35-38.

In col. 1, lines 59-66, col. 2, lines 8-13, col. 6, lines 9-22, col. 7, lines 26-36, and the examples, Abdou-Sabet et al. teach an at least partially cured thermoplastic elastomeric composition comprising 25-85 parts of an ethylene-based copolymer rubber, 15-75 parts of a crystalline polypropylene resin and 5 to 300 parts, based on a total 100 parts of the polymer resins/rubbers, of a mineral oil softening/extender oil, such as a paraffinic oil.

While Rinehart, Mathews et al. or Abdou-Sabet et al. do not expressly teach the disclosed properties in the claimed composition (i.e., the evaporation loss or kinetic viscosity of the paraffinic oil), it is reasonable that the composition of Rinehart, Mathews et al. or Abdou-Sabet et al. would possess the presently claimed properties since the compositions, including the paraffinic oils, of Rinehart, Mathews et al. or Abdou-Sabet et al. are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

24. Claims 1-8, 11-13 and 17-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Sezaki et al. (USPN 4,728,692) or Ottawa et al. (USPN 4,818,785).

In col. 1, lines 57-65, col. 2, lines 6-59 and col. 3, lines 51-58, Sezaki et al. teach an at least partially cured thermoplastic elastomeric composition comprising 10-120 of an ethylene-based copolymer rubber, 10-90 parts of a crystalline polypropylene resin, 1-90 parts of a modified polyolefin, such as polyethylene, and up to 150 parts of a mineral oil softening/extender oil, such as a paraffinic oil.

In col. 3, lines 28-48, col. 4, lines 13-26, col. 5, lines 53-62, col. 10, lines 44-48, col. 12, lines 45-50 and the examples, Ottawa et al. teach an at least partially cured thermoplastic elastomeric composition comprising 1-90 parts of an ethylene-based copolymer (rubber), which has a hot toluene insolubles content (gel content) of 15% or more, 10-99 parts of a crystalline polypropylene resin and 5 to 300 parts of a paraffinic mineral oil softening/extender oil, wherein the ethylene-based copolymer is a polyethylene comprising up to 92% of ethylene units.

While Sezaki et al. or Ottawa et al. do not expressly teach the disclosed properties in the claimed composition (i.e., the evaporation loss or kinetic viscosity of the paraffinic oil), it is reasonable that the composition of Sezaki et al. or Ottawa et al. would possess the presently claimed properties since the compositions, including the paraffinic oils, of Sezaki et al. or Ottawa et al. are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old

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composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE  
October 10, 2002